



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/756,257 | 11/25/1996 | JOHN D. SCHELLENBERG | 4204.7-1 | 2922 |

27885 7590 07/21/2006

FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP
1100 SUPERIOR AVENUE, SEVENTH FLOOR
CLEVELAND, OH 44114

| |
|----------|
| EXAMINER |
|----------|

SMITH, RUTH S

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3737

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/756,257

Applicant(s)

SCHELLENBERG, JOHN D.

Examiner

Ruth S. Smith

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7, 9, 11-13, 15, 22, 26, 29, 31 and 42-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 26 is/are allowed.
- 6) ☒ Claim(s) 1, 7, 9, 11-13, 15, 29 and 42-49 is/are rejected.
- 7) ☒ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

Claims 11,15,31,48,49 are objected to because of the following informalities:
Claim 11 depends from cancelled claim 10. For purposes of examination, the examiner will assume that claim 11 should depend from claim 1. In claim 15, line 3, the recitation of "the tool..." following "the apparatus comprising" is confusing. In claim 15, line 12, it is unclear as to which "determining means" is being referred to. The language set forth in claim 31 appears to be inconsistent with claim 26. Claim 26 sets forth that the display is remote from the tool, however, claim 31 sets forth that the display includes LEDs mounted to the tool. In claim 49, "the display mechanism" lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1,7,9,11-13,15,48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is vague and indefinite in that it defines the display means in terms of an unclaimed element such as the tool. Claim 15 is vague and indefinite in that it attempts to define the display means in terms of its relationship to an unclaimed tool having a pointing axis.

Claims 1,7,9,11-13,15,48 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: Claim 1 fails to positively set forth the tool as part of the claimed invention. It is unclear as to how the apparatus can provide movement of the tool without such elements being part of the claimed invention. Furthermore, it is unclear as to how the position of the display means can be defined without the tool being part of the claimed invention. Claim 15 includes the same deficiencies as claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,7,11-13,15,29,42-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manwaring et al in view of Wilk et al (WO 93/15648). Manwaring et al discloses an apparatus which includes a surgical tool and means for determining the actual position of the distal end of the tool relative to a desired position of the tool. Manwaring et al further provides a display for indicating such differences in position. Reference numeral 46 represents an indicator having electronic indicators which provide an indication to a human operator of a direction in which the tool should be moved to reach a desired position. With respect to claims 46, 47, it appears that the indicated direction that the tool must be moved is relative to a reference frame of the tool. Wilk et al disclose a surgical tool having a display on the tool. It would have been obvious to one skilled in the art to have modified Manwaring et al such that the display is mounted on the tool in order to provide a more compact system. The power source of the system would provide a means for activating the indicating means and the use of the modified system would result in the performance of the claimed method. With respect to claim 1, the modified Manwaring et al system would result in the difference being indicated with respect to the indicator reference frame. With respect to claim 13, in the absence of any showing of criticality, the specific type of information displayed to an operator would have been obvious design choice to one skilled in the art. With respect to claims 15,29, having the display means attached to the tool would result in determining the position of the display means when one determines the position of the tool. With respect to claim 29,49, in the absence of any showing of criticality, the specific type of indicator used would have been an obvious design choice of known functional equivalents in the art.

Allowable Subject Matter

Claims 22,26 are allowable over the prior art of record.

Response to Arguments

Applicant's arguments filed May 11, 2006 have been fully considered but they are not persuasive. The examiner does not agree with applicant's understanding of the Manwaring reference. Display 46 includes several different indicators. Furthermore, if the display 46 is mounted on the tool as disclosed by Wilk, it would provide an indication in the frame of reference of the tool, as well as the indicator. It should be noted that the new grounds of rejection for claims 1,7,11-13 is due to the amendment to claim 1, line 6.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

Art Unit: 3737

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Ruth S. Smith', is positioned above the printed name and title.

Ruth S. Smith
Primary Examiner
Art Unit 3737

RSS